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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Paul C. Kocher et al.

Application No.: 10/695,256

Filed: 10/27/2003

For: USING SMARTCARDS OR OTHER
CRYPTOGRAPHIC MODULES FOR
ENABLING CONNECTED DEVICES
TO ACCESS ENCRYPTED AUDIO
AND VISUAL CONTENT

M/S AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Confirmation No.: 4709

Group Art Unit: 2132

Examiner: not yet known

Attorney Docket No: 44424162-8746

**INFORMATION DISCLOSURE
STATEMENT**

SONNENSCHEIN NATH & ROSENTHAL LLP
Customer No. 26263

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope, addressed to: M/S Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 23, 2004.

SONNENSCHEIN NATH & ROSENTHAL LLP

Dated: 23 Sep 04 By: 

Michael C. Martensen

Sir:

Applicants submit herewith patents, publications or other information [attached hereto and listed on the attached Form PTO-1449 (modified)] of which they are aware, which they believe may be material to the examination of this application and in respect of which there may be a duty to disclose in accordance with 37 CFR § 1.56.

This Information Disclosure Statement:

- (a) accompanies the new patent application submitted herewith. 37 CFR § 1.97(a).
- (b) is filed within three months after the filing date of the application or within three months after the date of entry of the national stage of a PCT application as set forth in 37 CFR § 1.491.
- (c) as far as is known to the undersigned, is filed before the mailing date of a first Office Action on the merits, or before a first office action after filing a Request for Continued Examination under §1.114.

- (d) is filed after the first office action and more than three months after the application's filing date or PCT national stage date of entry filing but, as far as is known to the undersigned, prior to the mailing date of either a final rejection or a notice of allowance, whichever occurs first, and is accompanied by either the fee (\$180) set forth in 37 CFR § 1.17(p) or a certification as specified in 37 CFR § 1.97(e), as checked below.
- (e) is filed after the mailing date of either a final rejection or a notice of allowance, whichever occurred first, and the Issue Fee has not been paid, and is accompanied by the fee (\$130) set forth in 37 CFR § 1.17(i)(1) and a certification as specified in 37 CFR § 1.97(e), as checked below. This document is to be considered as a petition requesting consideration of the information disclosure statement.

A list of the patent(s) or publication(s) is set forth on the attached Form PTO-1449 (Modified). A copy of the items on PTO-1449 (Modified) is supplied herewith, except as noted below.

Those patent(s) or publication(s) which are marked with an asterisk (*) in the attached form PTO-1449 (Modified) are not supplied because they are (a) either U.S. Patents and this an application filed after June 30, 2003, or (b) were previously cited by or submitted to the Office in prior U. S. Patent Application No. 09/948,473, filed 09/06/2001, now U.S. Patent No. 6,640,305 which is a continuation of U.S. Patent Application No. 09/389,268, filed 09/02/1999, now U.S. Patent No. 6,289,455, and relied upon in this application for an earlier filing date under 35 U.S.C. § 120.

A concise explanation of relevance of the items listed on form PTO-1449 (Modified) is:

- (h) not given
- (i) given for each listed item
- (j) given for only non-English language listed item(s) [Required]
- (k) is in the form of an English language copy of a Search Report from a foreign patent office, issued in a counterpart application, which refers to the relevant portions of the references [copy attached].

The Examiner is reminded that a "concise explanation of the relevance" of the submitted items "may be nothing more than identification of the particular figure or paragraph of the patent or publication which has some relation to the claimed invention," MPEP § 609.

While the information and references disclosed in this Information Disclosure Statement may be "material" pursuant to 37 CFR § 1.56, it is not intended to constitute an admission that any patent, publication or other information referred to therein is "prior art" for this invention unless specifically designated as such.

In accordance with 37 CFR § 1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 CFR § 1.56(a) exists. It is submitted that the Information Disclosure Statement complies with 37 CFR § 1.98 and MPEP § 609 and the Examiner is respectfully requested to consider the listed references.

The Commissioner is hereby authorized to charge our Deposit Account No. 19-3140, for any fees required in connection with the filing of this Information Disclosure Statement. **A duplicate copy of this Notice is enclosed for this purpose.** In particular, in the event that an Office Action has crossed in the mail with this Information Disclosure Statement, the Commissioner is authorized to charge the above-named deposit account for any fees required pursuant to CFR §§ 1.17(p) or 1.17(i)(1).

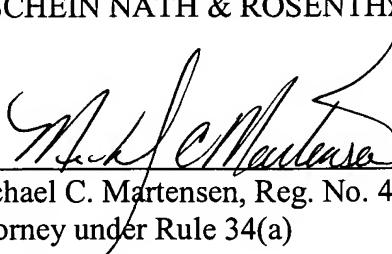
This request is made on behalf of the applicants and their assignee under 37 CFR 1.34(a). The Commissioner is hereby authorized to credit overpayments or to charge any deficiency in connection with this filing to Deposit Account No. 19-3140. A duplicate copy of this sheet is enclosed.

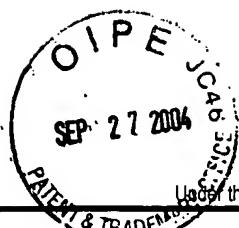
Respectfully submitted,

SONNENSCHEIN NATH & ROSENTHAL LLP

Dated: 23 September 2004

By:


Michael C. Martensen, Reg. No. 46,901
Attorney under Rule 34(a)



Substitute for form 1449A/PTO				Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(use as many sheets as necessary)</i>				Application Number	10/695,256
				Filing Date	October 27, 2003
				First Named Inventor	Paul C. Kocher
				Group Art Unit	2132
				Examiner Name	not yet known
Sheet	1	of	3	Attorney Docket Number	44424162-8746

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			
AA		*4,222,068	09/09/1980	Thompson	
AB		*4,521,852	06/04/1985	Guttag	
AC		*4,521,853	06/04/1985	Guttag	
AD		*4,613,901	09/23/1986	Gilhousen et al.	
AE		*4,634,808	01/06/1987	Moerder	
AF		*4,696,034	09/22/1987	Wiedemer	
AG		*4,887,296	12/12/1989	Horne	
AH		*5,029,207	07/02/1991	Gammie	
AI		*5,237,610	08/17/1993	Gammie et al.	
AJ		*5,293,424	03/08/1994	Holtey et al.	
AK		*5,436,621	07/25/1995	Macko et al.	
AL		*5,442,704	08/15/1995	Holtey	
AM		*5,592,552	01/07/1997	Fiat	
AN		*5,619,247	04/08/1997	Russo	
AO		*5,754,647	05/19/1998	Hsu	
AP		*5,757,919	05/26/1998	Herbert et al.	
AQ		*5,764,762	06/09/1998	Kazmierczak et al.	
AR		*5,774,546	06/30/1998	Handelman et al.	

FOREIGN PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Foreign Patent Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Country Code ³ Number ⁴ Kind Code ⁵ (if known)			
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					<input type="checkbox"/>

Examiner Signature	Date Considered
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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				Group Art Unit	2132
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		Number-Kind Code ² (if known)			
	AS	*5,799,080	08/25/1998	Padmanabhan et al.	
	AT	*5,802,274	09/01/1998	Dorak et al.	
	AU	*5,809,140	09/14/1998	Rubin et al.	
	AV	*5,825,878	10/20/1998	Takahashi et al.	
	AW	*5,852,290	12/22/1998	Chaney	
	AX	*5,892,899	04/05/1999	Auicsmith et al.	
	AY	*5,892,900	04/06/1999	Ginter et al.	
	AZ	*5,923,759	07/13/1999	Lee	
	BA	*5,982,899	11/09/1999	Probst	
	BB	*5,999,623	12/07/1999	Bowman et al.	
	BC	*6,009,177	12/28/1999	Sudia	
	BD	*6,041,412	03/21/2000	Timson et al.	
	BE	*6,044,155	03/28/2000	Thomlinson et al.	
	BF	*6,049,608	04/11/2000	Ablowitz et al.	
	BG	*6,069,957	05/30/2000	Richards	

FOREIGN PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Foreign Patent Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Country Code ³ Number ⁴ Kind Code ⁵ (if known)			
					<input type="checkbox"/>
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Examiner Signature	Date Considered
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Approved for use through 10/31/2002. OMB 0651-0031

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Substitute for form 1449B/PTO				Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(use as many sheets as necessary)</i>				Application Number	10/695,256
Sheet	3	of	3	Filing Date	October 27, 2003
				First Named Inventor	Paul C. Kocher
				Group Art Unit	2132
				Examiner Name	not yet known
				Attorney Docket Number	44424162-8746

OTHER ITEMS – NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	CiteNo. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
	BH	*CHOR, B., et al. "Tracing Traitors", Advances in Cryptology-CRYPTO '94 (Springer-Verag, 1994), pp. 256-270 (Cambridge, United Kingdom).	
	BI	*"H' Cards and You: The 'H' Card Hacking FAQ", By an Anonymous Member of TCUP, revision date August 10, 1998, world wide web at Http://www.dr7.com/faqs/dsstechfaq.html .	
	BJ	*KOMMERLING, O. and Kuhn, M., "Design Principles for Tamper-Resistant Smartcard Processors," USENIX Workshop on Smartcard Technology, May 10-11, 1999, USENIX Association, pp. 1-12, 9-20, ISBN 1-1880446-34-0 (Cambridge, United Kingdom).	
	BK	*McCORMAC, J., "European Scrambling Systems," (Circuits, Tactics and Techniques. 5) Waterford University Press 1996 (Waterford, Ireland).	

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¹ Unique citation designation number. ² Applicant is to place a check mark here if English language Translation is attached.

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